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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,527	09/12/2003	Tetsuro Motoyama	241499US2CONT	5289

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EXAMINER

PRIETO, BEATRIZ

ART UNIT PAPER NUMBER

2142

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,527

Applicant(s)

MOTOYAMA ET AL.

Examiner

Prieto B.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/06 & 8/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to request for reconsideration under 37 CFR 1.11 of claims 1-16, which remain pending.

2. Information Disclosure Statement (IDS) under 37 CFR 1.97 filed 06/27/06 & 08/22/06, comprising a list of applicant's pending application(s), published application(s) or issued patent(s) which may be related to the present application, has been considered, initialed and enclosed accordingly.

Double Patenting Rejection

3. Quotation of non-statutory double patenting rejection based on a judicially created doctrine may be found in previous office action.

4. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of US 5,544,289 (referred to as patent '289 hereafter) in view of Barrett et. al. (US 5,935,262). Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application is an obvious variation of the '289 patent.

Details of this rejection are hereby incorporated by reference as found in previous office action.

Claim Rejection under 35 U.S.C. 103

5. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

6. Claims 1-3, 5-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mil (US 5,282,127) in view of Sekizawa (US 6,430,711).

Details of this rejection are hereby incorporated by reference as found in previous office action.

7. Claims 4, 8 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mil in view of Sekizawa in further view Danknick et. al. U.S. Patent No. 5,901,286 (Danknick hereafter)

Details of this rejection are hereby incorporated by reference as found in previous office action.

Response to Arguments

8. Applicant traverses the obviousness type double patenting rejection of claim 1 and 3. Specific arguments (p. 8-9 of remarks) regarding non-statutory double patenting rejection based on a judicially created doctrine are that: claim 1 of the '289 patent fails to recite (i) obtaining by a first monitoring status information from sensors of an image handling device, as recited in claim 1 of instant application.

Thus, the patent '289 according to applicant, "only refers to semi-static data, which includes data which may change infrequently over a life of the business office device".

In response to the above-mentioned argument, the scope/breadth of the claim language "semi-static data, which includes data which may change infrequently over a life of the business office device" encompass data from the image handling device (copier, printer, etc.) does not exclude status information, nor does it exclude static data, since the claim language further limits the term "semi-static data" as data that is not require to change (although it may change) over a life of the business office device, thus not distinguishable over status, dynamic or static information obtained from sensors. Barrett discloses where status information from an image handling device/business office device, such as a copier, includes data that may change over a life of the business office device. Specifically, status information regarding a printer, e.g. the number of jobs sent to printer 102 and the date, online status information, as well as I/O status, paper out status, and printer busy status, the number of pages in a job, etc. (see Barrett column 13, lines 26-36). The rejection is under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,631,247 (referred to as patent '247 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262

9. Applicant traverses the obviousness type double patenting rejection of claim 1 and 3. Specific arguments (p. 8-9 of remarks) regarding non-statutory double patenting rejection based on a judicially created doctrine are that: claim 1 of the '289 patent fails to recite (i) processing the stored device information by the first monitoring device to generate a usage report of the image handling device, wherein the period usage report is based on the status information obtained for a predetermined time.

In response to the above-mentioned argument, the scope/breadth of the claim language "semi-static data, which includes data which may change infrequently over a life of the business office device" encompass data from the image handling device (copier, printer, etc.) does not exclude status information, nor does it exclude static data, since the claim language further limits the term "semi-static data" as data that is not require to change (although it may change) over a life of the business office device, thus not

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distinguishable over status, dynamic or static information obtained from sensors. Barrett discloses where status information from an image handling device/business office device, such as a copier, includes data that may change over a life of the business office device. Specifically, where status information regarding a printer, is obtained over a period of time, e.g. once midnight is reached, the process advances to S903, where microprocessor 173 calculates printer statistics such as jobs per day. The printer interface (NED 1001) keeps track of the number of jobs sent to printer 102 and the date. That information can be stored in the log file. In addition, interface can monitor the online status of printer 102, as well as I/O status, paper out status, and printer busy status. The interface can use such information to calculate statistics such as number of jobs per day and number of minutes that printer 102 is offline (see Barrett column 13, lines 26-36). Barrett teaches transmitting status information to a remote computer (see col 2/lines 1-26) and generating a report using status information, see Fig. 29 and col 35/lines 16-50. The rejection is under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,631,247 (referred to as patent '247 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262.

10. Applicant traverses the obviousness type double patenting rejection of claim 1 and 3. Specific arguments (p. 8-9 of remarks) regarding non-statutory double patenting rejection based on a judicially created doctrine are that: claim 1 of the '289 patent fails to recite (i) obtaining by a first monitoring status information from "sensors" of an image handling device, as recited in claim 1 of instant application.

In response to the above-mentioned argument, Barrett discloses the receiving status information "sensors". According to Barrett, printer status information which could be transmitted from printer 102 to NEB 101 includes: *transient state; online, printing; offline, not printing; engine test detected; maintenance program running; in sleep mode; paper out; printer open; paper jam; no EP cartridge; toner low; U-L feed; load paper; feed paper; CaPSL operator call; upper feeder reject; middle feeder reject; lower feeder reject; set upper; set middle; paper drain; tray full; page full; 22 LINE ERROR; 40 LINE ERROR; download memory full; working memory full; deadlock memory full; job reject; print check; font full; engine warming up; external operator call; front card removal; NVRAM full; hard disk full; memory full; low resolution, can't switch to low; hard disk crash; "please power off"; full paint reject; scale error; duplex reject; expansion I/O error; tray trouble; resident ROM: bad format; not supported option; no option font; unavoidable memory full; service call is active; starting state; going offline;*

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going online; offline, not printing, in a menu; transient, menu finished, return to OFFLINE; panel reset requested; SWOFF detected (power down request); reboot system; panel form feed requested; panel form feed cancelled; external program test print; test print cancelled; maintenance program done; and the like. (Barrett: column 26, lines 12-33).

Status information obtained from “sensors” of an image-handling device is obvious in view of the teachings of Barrett. The rejection is under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,631,247 (referred to as patent ‘247 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262.

11. Applicant traverses the obviousness type double patenting rejection of claim 1 and 3. Specific arguments (p. 9-10 of remarks) regarding non-statutory double patenting rejection based on a judicially created doctrine are that: claim 1 of the ‘289 patent fails to recite (i) where the device information obtained “*over the Internet*”, thus according to applicant, patentable distinct from instant application.

In response to the above-mentioned argument, Barrett teaches where the interface of the image handling device, i.e. printer is configured with an TCP/IP protocol stack (see Barrett column 9, lines 26-33); because many communication protocol types may be broadcast on local area network (100), the device includes software modules for supporting multiple protocols, including monitoring all network traffic on the heterogeneous network to determine the protocol type or types in use, and loads the protocol stack or stacks which correspond to the protocols it detects into memory 2175 (see column 10, lines 52-58).

Obtaining by a first monitoring computer over the Internet, device information of the image handling device, the information including status information of the image handling device is obvious on view of the teachings of Barrett. The rejection is under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,631,247 (referred to as patent ‘247 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262.

12. Regarding rejection of claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Mil (US 5,282,127) in view of Sekizawa (US 6,430,711), it is argued (p. 11 of remarks) that the Sekizawa reference does not disclose that such information is obtained by a first monitoring computer over the

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Internet. Because according to applicant, the reference discloses that the agent units 10 obtain the information from the printers over a local area network, the cited passage from columns 18 and 19 of the Sekizawa reference merely indicates that the second-type network can be the Internet or an equivalent network. However, according to Applicant, this passage while it *may bear on the transmitting step recited in Claim 1 in which the usage report is transmitted over the Internet* from a first monitoring computer to a second monitoring computer, Applicants respectfully submit that it is unrelated to the obtaining step recited in Claim 1. The '711 patent discloses that the information is obtained from the network printers by a local area network prior to transmission over the Internet.

In response to the above-mentioned arguments, applicant's interpretation of the applied reference has been fully considered. However, Sekizawa teaches that *every type of computer network can be adopted as the second-type computer network so long as the computer network provides terminal-to-terminal information transfer service through electronic mail and connects LANs (see column 19, lines 1-6)*. In a second embodiment of the invention specifies that the first-type computer network in the first embodiment is a local area network and the second-type computer network is the Internet. If the Internet is thus adopted, the communication costs can be more decreased as compared with the conventional system using a facsimile machine, etc., because the Internet covers almost all the world. Since the Internet eliminates local problems, the integrated monitor unit can be installed anywhere. Thus, the state of each of the machines installed in various areas can be monitored in batch at one or several sites; the number of persons required for monitoring the machine state can be decreased and service can be improved (see col 3/lines 50-col 4/line 5). Given the suggestions of Sekizawa one would be motivated to apply the suggestions of Sekizawa for obtaining by a first monitoring computer over the Internet and the communication between the first monitoring computer and the second monitoring computer is over the Internet, because in doing so the communication costs can be more decreased as compared with the conventional system using a facsimile machine, etc., because the Internet covers almost all the world. Since the Internet eliminates local problems, the integrated monitor unit can be installed anywhere. Thus, the state of each of the machines installed in various areas can be monitored in batch at one or several sites; the number of persons required for monitoring the machine state can be decreased and service can be improved, as suggested by Sekizawa.

Thus, arguments that the applied reference(s) fail to teach claim limitation as now amended, specifically, obtaining by a first monitoring computer *over the Internet* and the communication between the first monitoring computer and the second monitoring computer is over the Internet has been considered but not found persuasive.

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13. Applicant's arguments filed in the response indicated above have been fully considered but not found persuasive.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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B. Prieto
Primary Examiner
November 3, 2006


BEATRIZ PRIETO
PRIMARY EXAMINER